

### **REMARKS**

The January 15, 2009 Advisory Action was based on pending Claims 1–11, with Claim 1 being the only independent claim.

Applicant thanks the Examiner for the careful and thoughtful consideration of Applicant's previous arguments and amendments submitted in Applicant's paper filed December 15, 2008.

By way of this Response, no claim amendments are being presented, and Applicant respectfully requests reconsideration of the pending claims in view of the remarks set forth below.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Final Office Action rejects Claims 1–11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,069,386 to Jos ("Jos") in view of U.S. Patent Application Publication No. 2002-0003247 to Yokoyama et al. ("Yokoyama").

In particular, the Final Office Action indicates that Jos teaches the invention recited in Claim 1 except that "Jos does not teach the electrical connection between the further metal strip (524) and the metal source contact (515) comprises a capacitor." The Final Office Action then cites Yokoyama for teaching "an electrical connection between a metal source contact and further metal strip comprises a capacitor to improve device performance." The Final Office Action then concludes that "it would have been obvious to one of ordinary skill in the art . . . to have modified the electrical connection taught by Jo [sic] to be a capacitor to improve device performance as taught by Yokoyama."

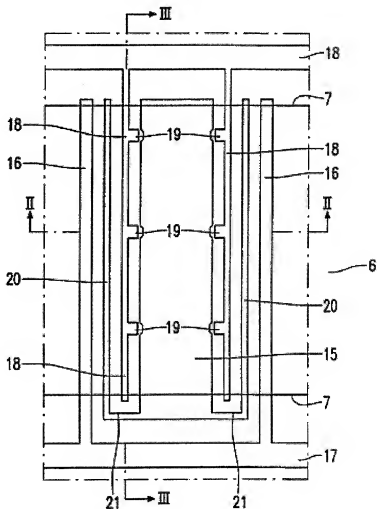
Applicant respectfully traverses this rejection and the Final Office Action's characterization of the cited references. In particular, Applicant respectfully submits that Claims 1–11 are patentably distinguished over the cited references because: (1) there is no reasonable expectation of success in the proposed combination of Jos and Yokoyama to teach the claimed invention; and (2) there is no further suggestion or motivation to combine Jos and Yokoyama.

**There is No Reasonable Expectation of Success in the Proposed Combination of Jos and Yokoyama**

A *prima facie* case of obviousness requires that there be a reasonable expectation of success in combining the teachings of the prior art (see, e.g., M.P.E.P. § 2143.02(I) stating that "[t]he prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success").

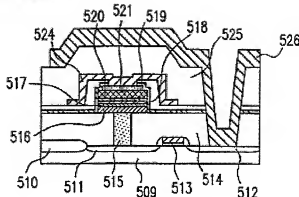
As shown in Figure 1 (reproduced to the right), Jos appears to teach placing a further metal strip or track (20), which serves as a capacitive screening between the gate electrode contact (18) and the drain contact (16) (see, e.g., col. 3 lines 47–52). Jos does not teach the addition of a capacitor between the further metal strip (20) and the source contact (15). Rather, Jos teaches that the further metal tracks (20) are connected to the source contact (15). Jos further teaches that the further metal strip (20) may be realized together with the source (15), drain (16) and gate contacts (18) in a common metal layer (see, e.g., Abstract and Figure 1).

Yokoyama appears to teach a three dimensional construction to form a capacitor between a further metal strip (524) that serves as a plate line of the capacitor and the source (see, e.g., paragraph 200 and Fig. 22C (reproduced below)).



**FIG. 1**

FIG. 22C



It would not be clear to one skilled in the art how to combine the three dimensional construction of Yokoyama into Jos so that there would be a capacitor between the further metal strip (20) and the source contact (15) without destroying Jos's invention. For example, such a combination could not be formed in a common metal layer as taught by Jos.

Additionally, according to Yokoyama's design, the further metal strip would need to be displaced upward away from the drain and gate and, as a result, would not serve as a capacitive screening between the gate contact (18) and the drain contact (16) as required by Jos. Thus, it is clear that one skilled in the art would not have considered amending Jos to include a capacitor according to Yokoyama's teachings, since such a combination would destroy the invention of Jos (see, e.g., M.P.E.P. § 2143.01(V) (stating "the proposed modification cannot render the prior art unsatisfactory for its intended purpose"); see also M.P.E.P. § 2143.01(VI) (stating "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious")).

### There is No Further Suggestion or Motivation to Combine Jos and Yokoyama

*A prima facie* case of obviousness requires that the prior art provide a suggestion or motivation to combine the teachings of the prior art or that there be a clear motivation to combine the teachings of the prior art.

Applicant respectfully submits that Jos does not suggest that his teachings are unsatisfactory and does not provide any motivation to search for an improvement to his teachings. Applicant further submits that it would not have been obvious to a skilled artisan to add a capacitor to Jos's invention to obtain better results without experimenting and determining that a capacitor would provide an improvement in certain cases, such as the results presented in Applicant's disclosure (see, e.g., Figures 6-8 and page 8, line 9, through page 9, line 34).

On the contrary, a skilled artisan may consider Jos's disclosure as the improvement, since Jos purports to improve performance without complicating the semiconductor design and avoids the extra cost by adding a capacitor. That is, Yokoyama teaches a capacitor configuration that is not taught by Jos, and Jos suggests using a further metal strip to screen between the drain contact and the gate contact, which is not taught by Yokoyama. One skilled in the art would assume that one design is better for some applications and the other design would be better for other applications. A combination of the two references could provide a result that would lack the benefits of each individual case and would, thus, be undesirable (e.g., a complex, expensive construction with little or no improvement in performance). In view of the foregoing, Applicant submits that there would be no motivation to combine Jos and Yokoyama.

#### **Summary**

Because the cited references cannot be properly combined to teach the claimed invention, Applicant asserts that Claim 1 is not obvious in view of Jos and Yokoyama, and Applicant respectfully requests allowance of Claim 1.

Moreover, Claims 2-11 depend from independent Claim 1 and are believed to be further patentably distinguished over the cited references for the additional features recited therein.

#### **NO DISCLAIMERS OR DISAVOWALS**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding

in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

### **CONCLUSION**

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain, the Examiner is cordially invited to contact the undersigned such that the issues may be promptly resolved.

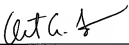
Moreover, by the foregoing remarks no admission is made that any of the above-cited references are properly combinable. Rather, Applicant submits that even if the references are combined, the references still do not teach or suggest the claimed invention.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 13, 2009

By:   
\_\_\_\_\_  
Christian A. Fox  
Registration No. 58,507  
Attorney of Record  
Customer No. 20995  
(949) 760-0404